Remarks

Claims 1-2, 4-22 and 24-39 are pending in the present application. By this reply, claims 3 and 23 have been canceled. Claims 1, 18, 21 and 35 are independent.

35 U.S.C. § 103 Rejection

Claims 1-4, 8-25 and 30-39 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. (U.S. Patent No. 6,469,796) in view of Murphy et al. (U. S. Patent No. 6,076,110). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Without acquiescing to any of the Examiner's allegations in rejecting these claims, to expedite prosecution only, independent claims 1 and 21 have been amended to incorporate therein the subject matter of claims 3 and 23, respectively. Claim 18 has been amended to clarify the invention.

Regarding independent claims 1, 18, 21 and 35, the Examiner alleges that Leiman et al. teaches the reason for non-suitability and cites column 8, lines 12-14 of Leiman et al. to support his position (see page 7, last paragraph of the final Office Action). At a closer look, however, what Leiman et al. actually teaches is a device that indicates via the GUI "that the print job cannot be printed on the selected printer by not allowing the print option to be selected or by not allowing the print job to be dropped onto the printer icon" (Leiman et al., column 8, lines 15-18). That is, in Leiman et al., the actual reason for the non-suitability is not indicated via the GUI. Instead, when the non-suitability is detected, the print

option for the print job is merely disabled, i.e., by not allowing the print option to be selected or by not allowing the print job to be dropped onto the printer icon. This means that the operator cannot see the actual reason for the non-suitability of the print job and that the operator cannot make a well-informed decision whether the reason for non-suitability is pertinent for the print job.

In complete contrast, in Applicants' embodied invention, the device indicates a reason for non-suitability via the presentation means, for example, see the window 306 in Figure 3E. By indicating a reason for the non-suitability, the operator can make a decision whether or not he wants to print a print job on that printer and possibly overrule the information and execute the print job on that printer after all. Clearly, this feature is completely absent from Leiman et al.

Furthermore, Murphy et al. does not overcome this deficiency of Leiman et al. since Murphy et al. is directed to the process of negotiating operations between a server and a client and merely involves communicating a device name from a client to a server. Thus, even if the references are combinable, assuming *arguendo*, the combination of these references does not render obvious at least the above-noted features as recited in independent claims 1, 18, 21 and 35.

In the alternative, regarding independent claims 1 and 21, the combination of references as applied by the Examiner fails to teach or suggest, *inter alia*:

> automatically checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the job . . .
>
> after that, receiving a selection of a processing device belonging to the set

as recited in independent claim 1; and

> research means for checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the defined job. . .
>
> selection means for selecting a processing device from the set based on the indication

as recited in independent claim 21.

Responding to Applicants' previous argument that these features as claimed are neither taught nor suggested by the combined references, the Examiner states that these features are not in the claims; see page 7, lines 10-13 of the final Office Action. However this is not true. Independent claim 1 clearly recites "automatically checking whether all processing devices belonging to a predetermined set selected from the plurality of processing devices are suitable for performing the job;...after that, receiving a selection of a processing device belonging to the set". Similar features are recited in claim 21 without the word "automatically". Thus, the Examiner is respectfully requested to reconsider Applicants' arguments.

In Leiman et al., it is only *after* the desired printer has been selected, that the system checks whether the set-up of the selected printer matches the print-job set-up. If the set-ups do not match, the print job cannot be printed and a new selection of a printer has to be made by a user. In contrast, in Applicants' embodied invention, the system checks all processing devices belonging to a predetermined set selected from a plurality of processing devices and determines whether any of them are suitable for performing the print job, and presents, for

each processing device of this set, whether that processing device is suitable for performing thejob. Only after that, the user selects a processing device from the set of processing devices to perform the job. This feature is clearly absent from the applied references, taken singularly or in combination.

Accordingly, independent claims 1, 18, 21, and 35 and their dependent claims (do to their dependency) are patentable over the applied references, and the rejection must be withdrawn.

Claims 5-7, 26, and 27-29 have been rejected under 35 U.S.C. 103(a) as being unpatenble over Leiman et al. in view of Murphy et al. and further in view of Applicants' disclosed background art. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As discussed above, the combination of Leiman et al. and Murphy et al. does not teach or suggest the invention as recited in independent claims 1 and 21 from which claims 5-7 and 26-29 depend. Furthermore, Applicants' disclosed background art does not overcome this deficiency since Applicants' invention is invented to overcome the limitations of Applicants' background art and the Examiner merely relies on Applicants' disclosed background art to teach a part of a job being a setting of a job.

Therefore, even if the references are combinable, assuming *arguendo,* the combination of reference would still fail to teach or suggest the invention as recited in independent claims 1 and 21 and their dependent claims due to their dependency. Accordingly, the rejection is improper and must be withdrawn.

Conclusion

For the foregoing reasons and in view of the above clarifying amendments, Applicants respectfully request the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicit an early issuance of a Notice of Allowance.

The Examiner is respectfully requested to enter this Amendment After Final, in that it raises no new issues but merely places the claims in a form more clearly patentable over the references of record. In the alternative, the Examiner is respectfully requested to enter this Amendment After Final in that it reduces the issues for appeal.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong (Registration No. 40,953) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit

Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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